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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,795	08/08/2005	Hugo De Vries	5100-000011/US	6854

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EXAMINER	
DENNIS, MICHAEL DAVID	
ART UNIT	PAPER NUMBER
3711	
MAIL DATE	DELIVERY MODE
11/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,795	DE VRIES ET AL.	
	Examiner	Art Unit	
	MICHAEL D. DENNIS	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15,18,20,22,23 and 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15,18,20,22,23 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is made Non-final in response to applicants Request for Continued Examination filed 7/16/2009. Claims 16-17, 19, 21, 26-27 are directed toward non elected claims. Claims 15, 18, 20, 22-23, and 25 are examined on the merits. It is noted that claims 21 and 26 are dependent to non elected claims and are therefore are non elected themselves.

Election/Restrictions

2. Applicant's election with traverse of Invention III in the reply filed on 10/6/2009 is acknowledged. The traversal is on the ground(s) that the restriction was based on improper standard and was not a search burden. This is not found persuasive. Applicant has alleged that the restriction is invalid because it is based on MPEP Chapter 800 restriction policy. Applicant asserts the PCT restriction standard should be applied to the U.S. application. Examiner disagrees. The U.S Patent Office restricts U.S. applications according to MPEP Chapter 800 restriction policy. Applicant alleges, moreover, that there is no search burden on examiner to examine each of the distinct inventions. Examiner disagrees. The mutually exclusive characteristics require different searches because the distinct inventions are structurally different. Examiner does not have time to search distinct inventions that are not obvious over one another. It's quite certain applicant would traverse a single reference applied in an obvious rejection to each of the different independent inventions. Finding different references for each distinct invention is a serious search burden. Lastly, applicant alleges wherein the examiner's previous search of the previous claims suggests that a serious search burden has not been established. Examiner disagrees. The restriction was necessitated by applicant's amendments filed

7/16/2009. The scope of the claims was changed such that distinct inventions were manifested, unlike the originally filed claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 15 recites the limitation "the layer". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 15-18 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Garcia.

As per claim 15, Garcia discloses a playable surface comprising a relatively hard substrate 14, at least one layer arranged thereon of a resilient and/or damping material 20, and a top layer 22 arranged in turn thereon, wherein air chambers 18 are formed in the relatively hard substrate and/or resilient and/or damping layer during or after arranging of the substrate or layer

respectively, wherein the air chambers are permanent because the inflatable dome shaped ribs are permanentl (Fig. 2-3; column 2; Abstract).

As per claim 18, Garcia discloses wherein the air chambers comprise spaces 26. It is noted that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (Fig.'s 3-4). See MPEP 2113.

As per claim 22, Garcia discloses wherein the top layer is synthetic turf (column 2).

As per claim 23, Garcia discloses an air flow device 26 connected to the air chambers for generating an air circulation therein (column 2).

7. Claims 15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Magnuson et al.

As per claim 15, Magnuson et al. discloses a playable surface, comprising a relatively hard substrate 13, at least one layer arranged thereon of a resilient and/or damping material 11 and a top layer 10 arranged in turn thereon, wherein permanent air chambers are formed in the relatively hard substrate and/or the layer of resilient and/or damping material (column 3, lines 14-26). Clearly, from Figures 1 and 4, one can see how the layer of a resilient and/or damping material 11 forms air chambers during or after arranging the layer because the air chambers are defined by the contours of the resilient and/or damping material. It is noted that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (Fig.'s 3-4). See MPEP 2113.

As per claim 20, Magnuson et al. discloses wherein a profiled mat 12 is arranged between the relatively hard substrate and the layer of resilient and /or damping material and over which

the resilient and/or damping material is spread, and wherein the air chambers are defined by the profile of the mat (column 3, lines 14-26).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Magnuson et al. in view of Friedrich.

As per claim 25, Magnuson et al. does not disclose wherein heating wires are received in the mat; however, Friedrich discloses that such features as placing an electrical cable heating means below a playing surface in well known in the art (column 7, lines 1-25). Relocating the receiving portion of the heating wires to a mat portion does not substantiate the feature. Hence, at the time of invention, one of ordinary skill in the art would have found it obvious to modify the playable surface discloses by Magnuson et al. with an electrical heating means as taught by Friedrich, as both Magnuson et al. and Friedrich are directed towards playable surfaces. The

motivation to combine references is to provide a field capable of withstanding harsh weather elements (column 3, lines 27-30).

Response to Arguments

10. Applicant's arguments filed 10/6/09 have been fully considered but they are not persuasive. Applicant argues wherein the air chambers are not permanently formed in the relatively hard substrate and/or the layer of resilient and/or damping material as applied in Garcia. Examiner disagrees. Fig. 2 of Garcia teaches wherein the air chambers are formed by ribs 18. Although the air circulation provided by the compressor may be temporary, the air chambers are inherent to the ribs which are permanently positioned in the playable surface. In other words, even a deflated rib 18 will comprise air chambers.

Applicant argues wherein the air chambers are not formed **in** the relatively hard substrate and/or the layer of resilient and/or damping material as applied to both primary references Garcia and Magnuson et al. Examiner disagrees. Fig. 2 of Garcia teaches wherein the ribs 18 are submerged with filler material 20 (layer of resilient and/or damping material), thus the permanent air chambers are also in the filler material. Applicant has not set forth claim language to define the structural relationship between the air chambers and layer of resilient and/or damping material, save "in". Per MPEP 2111, the Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard: The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the

specification as it would be interpreted by one of ordinary skill in the art." With respect to applied prior art of Magnuson et al.; the air chambers are clearly arranged in the layer of resilient and/or damping material per Figures 1 and 4. Since the air chambers are formed by the contours of the resilient and/or dampening material they are inherently formed after arrangement of the layer. It is noted that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (Fig.'s 3-4). See MPEP 2113.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL D. DENNIS whose telephone number is (571)270-3538. The examiner can normally be reached on 8:00 - 6:00 (off every other Fri.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MD
11/19/09
/Gene Kim/
Supervisory Patent Examiner, Art Unit 3711